REMARKS

The Examiner, Mr. Chu, is thanked for the courtesy extended applicants' attorney during the interview of November 5, 2003, during which time differences between the claimed invention and the cited art were discussed. It is noted that although the Examiner had forwarded suggested amendment of the claims which would be considered to distinguish over the cited art, as pointed out at the interview of November 5, 2003, the Examiner's suggested amendments were not considered acceptable and instead, applicant, after discussion with the Examiner, proposed amendment of claim 7 in the manner as presented by this amendment, which the Examiner indicated in the Interview Summary that the prior art do not show edge shifting values stored in a lookup table recorded on a recording medium, amendment which is distinguished with the prior art, and claim 20 dependent on claim 8, is not rejected in the Office Action. By the present amendment, claim 8 has been amended in a manner similar to claim 7, and dependent claim 20 has also been amended.

At the outset, applicants note that as pointed out to the Examiner at the interview, and as recognized by the Office Action Summary, claims 7-16, 19 and 20 are pending in the application. However, the Office Action provides no rejection of claim 20, which depends from claim 8, and since this claim is not rejected, it is assumed that this claim would stand allowed when rewritten in independent form. However, claim 20 has been retained in dependent form at this time, and a minor amendment effected therein.

Furthermore, as pointed out to the Examiner at the interview, only claims 7, 9-16 and 19 stand rejected under 35 U.S.C. 103(a) over the cited art in a proper statement of rejection, as set forth in paragraph 3 at page 3 of the Office Action. The statement at paragraph 4 at page 5 of the Office Action that:

> Claim 8 has limitations similar to those treated in the above rejection(s), and are met by the references as discussed above.

is not a proper a proper statement of the ground of rejection in accordance with Title 35 of the U.S. code and decisions relating thereto. Thus, applicants submit that claim 8 has also not been rejected in accordance with the requirements of the statute and rules and also is considered allowable since no proper rejection of claim 8 has been set forth.

As to the rejection of claims 7, 9-16 and 19 under 35 U.S.C. 103(a) as being unpatentable over Fuji (US Patent 6,310,846) in view of Lee (US Patent 5,241,524), this rejection is traversed insofar as it is applicable to the present claims, and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". The court pointed out:

> The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for

> providing automatic introduction by adding the proper
> programming software" and that "another motivation
> would be that the automatic demonstration mode is user
> friendly and it functions as a tutorial" do not adequately
> address the issue of motivation to combine. This factual
> question of motivation is immaterial to patentability, and
> could not be resolved on subjected belief and unknown
> authority. It is improper, in determining whether a person
> of ordinary skill would have been led to this combination
> of references, simply to "[use] that which the inventor
> taught against its teacher."... Thus, the Board must not
> only assure that the requisite findings are made, based
> on evidence of record, but must also explain the
> reasoning by which the findings are deemed to support
> the agency's conclusion. (emphasis added)

Applicants note that the Examiner mischaracterizes the recitation of a look-up

table as a form of data stored in a recording medium such as applicant's and Fuji's is

considered as a non-functional descriptive material, to be improper. Furthermore,

the Examiner's contention that it is obvious to store any type of data such as

applicant's and Fuji's descriptive material on a disk, is also improper.

In light of the discussion with the Examiner, applicants note that independent

claim 7 has been amended to more clearly recite the features thereof that the

recording medium enables writing of at least recording pulse thereon and that the

zone stores a lookup table having information about edge shifting values of at least

one of the leading and trailing edge of the at least one recording pulse to be written,

the edge shifting values being shifting amounts with respect to a reference clock,

and that the edge shifting values for the at least one recording pulse are obtained in

a particular manner. Applicants submit that the Examiner cannot ignore the recited

features in terms of the recording pulse which is to be written, and there is no

disclosure or teaching in Fuji and/or Lee taken alone or in any combination thereof of

a recording medium enabling writing of at least one recording pulse thereon, wherein

the zone stores a lookup table having information about edge shifting values of at

least one of the leading and trailing edge of the at least one recording pulse to be

written, the edge shifting values being shifting amounts with respect to a reference

clock. Furthermore, there is no disclosure or teaching of the edge shifting values for the at least one recording pulse are determined in the manner set forth in claim 7 or which serve for recording a mark 3Tw long, where Tw is a time width as recited in claim 8. Such features are clearly disclosed in the specification of this application, and the cited art of Fuji and Lee provide no disclosure or teaching thereof. As such, applicants submit that claim 7 as amended and the dependent claims patentably distinguish over the cited art in the sense of 35 U.S.C. 103, and applicants submit that apparently, this fact has been recognized by the Examiner as indicated in the Examiner Interview Summary.

As noted above, claim 8 has been amended in a manner similar to that of claim 7 and patentably distinguishes over the cited art for the reasons given above. As such, applicants submit that claim 8 and its dependent claim 20 should also be considered allowable at this time.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.37445CX1) and please credit any excess fees to such deposit account.

Respectfully submitted,

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